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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,411	03/25/2004	Toshihiro Mori	0649-0994PUS1	5118
2292 7590 06/11/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER LU, FRANK WEI MIN	
			ART UNIT	PAPER NUMBER
			1634	
			NOTIFICATION DATE	DELIVERY MODE
			06/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/808,411

Applicant(s)

MORI ET AL.

Examiner

Frank W. Lu

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19-24 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/04 and 7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species (2), claims 19-24 and 34-36 in the reply filed on February 22, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Since the examiner agrees to combine claims 1-24 and 34-36 together in the office action mailed on January 22, 2007 and newly claims 35 and 36 have been added, claims 1-15, 19-24, and 34-36 will be examined.

Information Disclosure Statement

2. Since the examiner cannot locate a legible copies for two Japanese documents in the IDS filed on June 16, 2004 and July 26, 2004, these documents have not been considered. Note that there is a patent abstract of Japan with publication number 05-268963 in the file. However, this document does not match either the Japanese document filed on June 16, 2004 or the Japanese document filed on July 26, 2004.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15, 19-24, and 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1 is rejected as vague and indefinite. Since the claim does not describe a solid phrase and a pressure sensor before the “wherein” phrases and the “wherein” phrases are used to define the subjects before the “wherein” phrases, it is unclear a solid phrase and a pressure sensor are parts of the structural limitations of the apparatus recited in claim 1 or not. Please clarify.

6. Claim 1 is rejected as vague and indefinite in view of the phrase “a pressure sensor capable of detecting the pressure in the accommodation part is connected” because it is unclear that a pressure sensor capable of detecting the pressure in the accommodation part is connected to which part of the apparatus. Please clarify.

7. Claim 11 is rejected as vague and indefinite in view of the phrase “An apparatus for separating and purifying nucleic acids which comprises a combination of at least two or more apparatuses for separating and purifying nucleic acids according to claim 1” because the apparatus recited in claim 1 does not comprise a combination of at least two or more apparatuses for separating and purifying nucleic acids. Please clarify.

8. Claim 13 is rejected as vague and indefinite because it is unclear that a pressure sensor recited in claim 13 is the same pressure sensor of claim 1 or not. If a pressure sensor recited in claim 13 is the same pressure sensor of claim 1, “a pressure sensor” in line 2 should be “the pressure sensor”. Please clarify.

9. Claim 15 recites the limitation “the nucleic acid-solubilizing agent” in the claim. There is insufficient antecedent basis for this limitation in the claim because there is no nucleic acid-solubilizing agent in claim 12. Please clarify.

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10. Claim 19 is rejected as vague and indefinite because it is unclear that a flow hole recited in step b) of claim 19 is the same flow hole of claim 1 or not. If a flow hole recited in step b) of claim 19 is the same flow hole of claim 1, “a flow hole” in step b) should be “the flow hole”. Please clarify.

11. Claim 20 is rejected as vague and indefinite because it is unclear that a pressure sensor and an accommodation part recited in claim 20 is the same pressure sensor and the same accommodation part in claim 1 or not. If a pressure sensor and an accommodation part recited in claim 20 is the same pressure sensor and the same accommodation part in claim 1, “a pressure sensor” and “an accommodation part” should be “the pressure sensor” and “the accommodation part”. Please clarify.

12. Claim 21 recites the limitation “the pressurization of the sample solution in step (b)” in the claim. There is insufficient antecedent basis for this limitation in the claim because claim 19 does not contain a step for pressurization of the sample solution. Please clarify.

13. Claim 21 or 22 recites the limitation “the container” in the claim. There is insufficient antecedent basis for this limitation in the claim because there is no word “container” in claims 1, 12, and 19. Please clarify.

14. Claim 24 is rejected as vague and indefinite because it is unclear that a pressure sensor recited in claim 24 is the same pressure sensor of claim 1 or not. If a pressure sensor recited in claim 24 is the same pressure sensor of claim 1, “a pressure sensor” in line 2 should be “the pressure sensor”. Please clarify.

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Conclusion

15. No claim is allowed.

16. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

April 30, 2007



FRANK LU
PRIMARY EXAMINER